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10/020,343

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EXAMINER

WOZNIAK, JAMES S

ART UNIT

PAPER NUMBER

2626

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/020,343

Applicant(s)

BERGSTRAESSER ET AL.

Examiner

James S. Wozniak

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned-patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the office action from 10/11/2006, the applicant has submitted an amendment, filed 4/11/2006, canceling all previously filed claims, while adding claims 46-64 and arguing to traverse the art rejection based on the limitation regarding transmitting document type information to a server (*Amendment, Page 7*). The applicant's arguments have been fully considered but are moot with respect to the new grounds of rejection, necessitated by the newly added claims and further in view of Janay et al (*U.S. Patent: 6,061,694*).

Claim Objections

2. **Claims 53-65** are objected to because of the following informalities:

Two claims are numbered 53, thus causing claim numbers 53-64 to be incorrect. The claims should be correctly renumbered. The claims will be referred to by their correct numbers for the remainder of the Office Action.

In claim 54 (incorrectly numbered claim 53), line 1, "devices" should be changed to – device--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 50, 58, and 64** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, claims 50, 58, and 64, recite that an indication of an application that has a document open at a client computing device is either sent from a client device or received at a server as further context, which is not disclosed in the specification. The specification only recites that context information includes user identity, user role, and type of document (*Page 12, first paragraph*), and not an indication of an application that has a document open. Thus, claims 50, 58, and 64 are directed towards new matter.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 55-65** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 55-65 are drawn to set of instructions, not a computer readable medium storing or embedding a program, as recited in the preamble (“computer-readable medium *with* instructions”) and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied *in* computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium *encoded with* a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 46-50, 54, and 61-64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokela et al (*U.S. Patent Publication: 2002/0184247*) in view of Allen et al (*U.S. Patent: 6,026,410*) and further in view of Janay et al (*U.S. Patent: 6,061,694*).

With respect to **Claims 46 and 61**, Jokela discloses:

Receiving from a user text entry into a document of a document type (*entering text into an application document, Paragraph 0021, wherein application documents are of different spreadsheet types (for example- weather, travel, stock prices, etc.), Paragraphs 0021, 0023, and 0025, or from different programs (for example word processing, presentation, or publishing applications), Paragraph 0026*);

Transmitting to a server computing device the text command and context (*transmitting a text command and a data block identifier to an aggregator server, Paragraph 0016*); and

Receiving from the server computing device an indication of an action to be performed on the document, the action being specific to the command and context (*retrieving and displaying a menu of smart tags and associated descriptions, Paragraphs 21-22, 24, and 26*), wherein the server computing device provides indications of different actions for the linguistic

component for different contexts (*smart tags that provide associations between specific documents and various data block resources, Paragraphs 0020-0023*); and

Performing the action on the document to exhibit a behavior in the document (*automatically entering tag data in a new or programmed spreadsheet or other application document, Paragraphs 21-22, 24, and 26*).

Jokela further discloses method implementation as a program stored in a computer memory (*paragraph 0015*).

Jokela does not specifically disclose parsing a text entry made by a user in a document to identify at least one linguistic component of the text entry, however Allen recites a method and system for carrying out an action in a document associated with a keyword that parses a natural language text input from a user for keyword identification (*Col. 5, Line 57- Col. 6, Line 11*).

Jokela and Allen are analogous art because they are from a similar field of endeavor in text document processing systems. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Jokela with the parsing means taught by Allen in order to implement a more efficient data entry means that allows a user to input commands in free form (*Allen, Col. 2, Lines 6-8; and Col. 9, Lines 9-12*).

Although Jokela seems to indicate that there is a correspondence between various Office document types and resource data blocks, a context indication of which is transmitted to an aggregator in addition to a text command (Paragraphs 0016 and 0020), Jokela does not explicitly disclose that the context information includes a document type. Janay, however, discloses the concept of transmitting a document type code to fill in appropriate data within a document (*Col. 3, Line 50- Col. 4, Line 26*).

Jokela, Allen, and Janay are analogous art because they are from a similar field of endeavor in text document processing systems. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Jokela in view of Allen with the document type code taught by Janay in order to ensure that data entered into a particular type of document is appropriate and correct (*Janay, Col. 1, Lines 32-38; and Col. 3, Lines 64-66*).

With respect to **Claims 47 and 62**, Jokela discloses an aggregator server that maintains a mapping between text commands and data blocks and indicates that there is a correspondence between various Office document types and resource data blocks, a context indication of which is transmitted to an aggregator in addition to a text command (Paragraphs 0016 and 0020), while Janay specifically teaches a document code, as applied to claim 46.

With respect to **Claim 48**, Jokela further discloses:

When a parsed linguistic component does not uniquely correspond to a linguistic component with a correspondence to an action, displaying an indication of multiple linguistic components, receiving from the user a selection of one of the multiple linguistic components, transmitting an indication of the selected linguistic component to the server computing device, receiving from the server computing device and indication of an action, and performing the action on the document (*retrieval and display of multiple annotations associated with an input command, selection of an annotation, retrieval of the selected annotation at the aggregator server, and entering the annotation into a document, Paragraphs 0021-0023*).

With respect to **Claims 49 and 63**, Janay further discloses:

The document type identifies a template (*document code associated with a template, Col. 4, Lines 8-26*).

With respect to **Claims 50 and 64**, Janay further discloses:

Transmitting to the server computing device an indication of an application that has the document open at the client computing device as further context (*associations between Office program documents and data blocks, transmitted data block information, Paragraphs 0016 and 0020, and various program applications that are associated with the documents, Paragraph 0026*).

With respect to **Claim 54 (second claim 53)**, Jokela further discloses:

The server computing device receives linguistic components and document types from multiple client computing devices (*communication between an aggregator server and multiple users, Paragraph 0026*).

9. **Claims 51-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokela in view of Allen et al in view of Janay et al and further in view of Goldberg et al (*U.S. Patent: 6,598,046*).

With respect to **Claims 51-52**, Jokela in view of Allen and further in view of Janay teaches the text parsing and tag identification method as applied to Claim 46. Jokela in view of Allen and further in view of Janay does not specifically teach providing tag access based upon a user's role, however Goldberg discloses document tags that are only accessible based on a user role identification (*Col. 4, Line 56- Col. 5, Line 38*).

Jokela, Allen, Janay, and Goldberg are analogous art because they are from a similar field of endeavor in text data processing. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Jokela in view of Allen and further in view of Janay with the user specific document tags as taught by Goldberg in order to implement a means for document retrieval that aligns more closely with the needs and strategies of an individual user (*Goldberg, Col. 2, Lines 31-43*).

10. **Claims 53 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokela et al in view of Allen et al in view of Janay et al and further in view of de Hita et al (*U.S. Patent: 6,081,774*).

With respect to **Claim 53 (first claim 53)**, Jokela in view of Allen and further in view of Janay teaches the text parsing and tag identification method as applied to Claim 46. Jokela in view of Allen and further in view of Janay does not specifically suggest specifying synonyms and linguistic annotations for a tag, however de Hita discloses a dictionary creation means for associating semantic (*synonym*) and syntactic data with a tag (*token*) (*Col. 3, Lines 1-20; and Col. 11, Lines 8-56*).

Jokela, Allen, Janay, and de Hita are analogous art because they are from a similar field of endeavor in information retrieval systems. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Jokela in view of Allen and further in view of Janay with the dictionary creation means taught by de Hita in order to ensure proper representation of a text's content (*de Hita, Col. 2, Lines 9-20*).

Claim 65 contains subject matter similar to Claim 53 (first claim 53), and thus, is rejected for the same reasons.

11. **Claims 55** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jokela in view of Janay et al.

With respect to **Claim 55**, Jokela discloses:

Providing a correspondence of linguistic components and contexts that includes document types to actions (*smart tags that provide associations between specific documents and various data block resources, Paragraphs 0020-0023*);

Receiving from a client computing device an indication of a linguistic component and a context (*receiving a text command and a data block identifier at an aggregator server, Paragraph 0016*);

Identifying an action that corresponds to the action of the indicated linguistic component and context (*comparing entered text to resource data blocks to retrieve an smart tag annotation, Paragraphs 0021-0025*); and

Sending to the client computing device an indication of the identified action so that the computing device can perform the action on the document to exhibit a behavior in the document (*transmitting and automatically entering tag data in a new or programmed spreadsheet or other application document, Paragraphs 21-22, 24, and 26*).

Jokela further discloses method implementation as a program stored in a computer memory (*paragraph 0015*).

Although Jokela seems to indicate that there is a correspondence between various Office document types and resource data blocks, a context indication of which is transmitted to an aggregator in addition to a text command (Paragraphs 0016 and 0020), Jokela does not explicitly disclose that the context information includes a document type. Janay, however, discloses the concept of transmitting a document type code to fill in appropriate data within a document (*Col. 3, Line 50- Col. 4, Line 26*).

Jokela and Janay are analogous art because they are from a similar field of endeavor in text document processing systems. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Jokela with the document type code taught by Janay in order to ensure that data entered into a particular type of document is appropriate and correct (*Janay, Col. 1, Lines 32-38; and Col. 3, Lines 64-66*).

12. **Claims 56-58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokela et al in view of Allen et al in view of Janay et al and further in view of de Hita et al (*U.S. Patent: 6,081,774*).

With respect to **Claim 56**, Jokela in view of Janay teaches the text parsing and tag identification method as applied to Claim 54. Jokela in view of Janay does not specifically suggest specifying synonyms and linguistic annotations for a tag, however de Hita discloses a dictionary creation means for associating semantic (*synonym*) and syntactic data with a tag (*token*) (*Col. 3, Lines 1-20; and Col. 11, Lines 8-56*).

Jokela, Janay, and de Hita are analogous art because they are from a similar field of endeavor in information retrieval systems. Thus, it would have been obvious to a person of

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ordinary skill in the art, at the time of invention, to modify the teachings of Jokela in view of Janay with the dictionary creation means taught by de Hita in order to ensure proper representation of a text's content (*de Hita, Col. 2, Lines 9-20*).

Claim 57 contains subject matter similar to Claim 48, and thus, is rejected for the same reasons.

Claim 58 contains subject matter similar to Claim 50, and thus, is rejected for the same reasons.

13. **Claims 59-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokela in view of Janay et al in view of de Hita et al and further in view of Goldberg et al (*U.S. Patent: 6,598,046*).

With respect to **Claims 59-60**, Jokela in view of Janay and further in view of de Hita teaches the text parsing and tag identification method as applied to Claim 55. Jokela in view of Janay and further in view of de Hita does not specifically teach providing tag access based upon a user's role, however Goldberg discloses document tags that are only accessible based on a user role identification (*Col. 4, Line 56- Col. 5, Line 38*).

Jokela, Janay, de Hita, and Goldberg are analogous art because they are from a similar field of endeavor in text data processing. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Jokela in view of Janay and further in view of de Hita with the user specific document tags as taught by Goldberg in order to implement a means for document retrieval that aligns more closely with the needs and strategies of an individual user (*Goldberg, Col. 2, Lines 31-43*).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Anderson et al (*U.S. Patent: 6,021,202*)- discloses a method for creating document type definitions.

Belfiore et al (*U.S. Patent Application Publication: 2002/0059425*)- discloses the use of smart tags in a document schema.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Wozniak whose telephone number is (571) 272-7632. The examiner can normally be reached on M-Th, 7:30-5:00, F, 7:30-4, Off Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached at (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James S. Wozniak
6/12/2007


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